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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/556,102	04/21/2000	Christopher T. Davey	BSC-134	6730

21323 7590 04/23/2003

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EXAMINER

DESANTO, MATTHEW F

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/556,102

Applicant(s)

DAVEY, CHRISTOPHER T.

Examiner

Matthew F DeSanto

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-23,25-34 and 36-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-23,25-34 and 36-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claims 13-16, 26-29, 39-41 is withdrawn in view of the newly discovered reference(s) to Walker et al. (USPN 5755693). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 12-23, 25-34, 36-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (USPN 5755693) and further in view of Deem et al. (USPN 5104389).

Walker et al. discloses a catheter with a sheath, a proximal hub portion, an elongated body portion, a passageway extending, a pair of lines extending at least some of the length of the sheath, wherein the sheath being separable along the lines, and a valve comprising a foam material, wherein the length of the foam material within the passageway being greater than the width of the foam material at any point within the passageway, and one or more self-sealing slits in the foam, but fails to disclose wherein none of the slits extend in width to the inner surface of the sheath.

Deem et al. discloses a sheath with a hub and an elongated body, wherein a foam valve is inserted into the hub and wherein the length of the foam material within

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the passageway being greater than the width of the foam material at any point within the passageway, and one or more self-sealing slits in the foam material, where none of the slits extend in width to the inner surface of the sheath, and where the foam material is affixed to a portion of an inner surface of the sheath that defines the passageway. As in claim 17,18, wherein the elongated body portion comprises at least a first section, and a second section, where the first cross-sectional area is larger than the second cross-sectional area and further comprises a shoulder disposed within the passageway and between the first and second sections. The reference shows a first cross-sectional area starting after the valve, and then the shoulder, and then the second cross-sectional area. As in claim 22, 34, 45 wherein the foam material comprises a closed cell foam.

At the time of the invention it would have been obvious for one of ordinary skill in the art to combine Walker et al. with Deem et al. because it is well known in the art to use a foam valve with non extending slits as well as closed cell foam as taught by Deem et al. for the purpose of helped in stabilizing and securing the trocar in relationship with the elongated body.

Therefore, it would have been obvious to combine Walker et al. with Deem et al. to obtain the invention as specified in claims 12-23, 25-34, 36-45.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F DeSanto whose telephone number is 1-703-305-3292. The examiner can normally be reached on Monday-Friday 8:30-6:00.

Matthew DeSanto
Art Unit 3763
April 10, 2003



MICHAEL J. HAYES
PRIMARY EXAMINER